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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,427	01/30/2001	David Lawrence	3499-93	9769

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EXAMINER

FULTS, RICHARD C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/772,427	Applicant(s) LAWRENCE, DAVID	
	Examiner Richard Fults	Art Unit 3628	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5,8,14,16,18,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,8,14,16,18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>8</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 3, 5, 8, 14, 16, 20, and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term “political exposure” is not defined in either the claims or the specifications and the algorithms are inadequately detailed to allow another person to duplicate the invention.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 3, 5, 8, 14, 20, and 21 are rejected as the claimed invention is directed to non-statutory subject matter because it does not claim the use of technology in the body of the claims.
3. Claims 1, 3, 5, 8, 14, 16, 20, and 21 are rejected as the claimed invention lacks patentable utility. The invention claims to evaluate risk associated with accounts held by a “politically identified person”. The description provides very little usable clear guidance as to how to objectively make this determination. Many subjective interpretive criteria

are involved in coming up with the end result and it is not clear that the end result is predictive or actually useful. The algorithms are not given nor are the necessary questions identified to produce the desired end result.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 5, 8, 14, 16, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taub (US 6,341,267 B1)(hereinafter Taub) in view of Horowitz et al (US6,349,290 B1( hereinafter Horowitz) and Bell (GB 2 354 608 A) (hereinafter Bell).

Taub discloses (see columns 1-30 but in particular columns 1-5) claims 1, 3, 5, 8, 14, 16, 20, and 21 as regards the computerized evaluation and gathering of information of personal behavioral and experience factors (politically identified person) in any specific role or situation (financial transaction), and structuring that information into useful criteria regarding probable behavioral patterns in applications to various work related activities, which activities could include financial transactions and political activities, including receiving information relating to political exposure relative to a financial transaction, structuring information according to risk quotient criteria, calculating a risk quotient using that information, suggesting an action responsive to the risk quotient including refusing to perform the transaction and notifying an authority, aggregating risk quotients relating to a financial institution, storing information and the

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risk quotient and the suggested action and generating reports, where the financial transaction is either opening or blocking a financial account, calculating an average risk quotient, and a computer server system accessible with a network access device and related connected software to receive information relating to political exposure of a person in a financial transaction. Taub does not teach risk issues per se and teaches only limited statistical analysis.

Horowitz discloses (see columns 1-48 but in particular columns 1-5) the computerized collection of personalized information (personal behavior (experience), financial aptitude, financial assets, and a combination of these factors) by a financial institution from a person with whom they are in a financial relationship.

Bell discloses (see pages 1-13 but in particular pages 1-3) a computerized method of statistically analyzing risk from financial transactions based on user data from the people involved in the financial transaction, using all the standard statistical and financial analysis methodology.

Given that the use and analysis of demographic/financial data and its application to the investigation of risk and detailed review of individuals/companies/cities/states/countries meeting certain criteria and business actions taken as a result of those analyses are old and well known, it would have been obvious to one skilled in the art at the time of the invention to apply those concepts of demographic evaluation and subsequent action and those of Taub to the evaluation of political risk exposure of a person involved in a financial transaction and action taken as a result of those analyses, and it would have been equally obvious to one skilled in the art at the time of the invention to have applied the concepts of Horowitz to the issue of political risk exposure of a person involved in a financial transaction and to have applied the concepts of Bell to the same issue.

6. Because it would have been common sense and advantageous and would have provided a more comprehensive and cost efficient method of analyzing financial risks relative to the political exposure involved it would have been obvious to one skilled in the art at the time of the of the invention to add the teachings of Horowitz and Bell to

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those of Taub, and and to add those of Taub to those of the others for the same reason.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.



RCF

7/7/2003-